



PTO/SB/21 (04-04)

1641
Btw**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number	09/980,751
Filing Date	November 1, 2001
First Named Inventor	Remaley, Alan T.
Art Unit	1641
Examiner Name	VENCI, David J.
Attorney Docket Number	015280-393100US

Total Number of Pages in This Submission

ENCLOSURES (Check all that apply)

- | | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input type="checkbox"/> Amendment/Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Response to Missing Parts/Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation
Change of Correspondence Address
<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund
<input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Technology Center (TC)
<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Return Postcard; Response to Restriction Requirement |
|---|---|---|

Remarks	The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.
---------	--

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Townsend and Townsend and Crew LLP	Reg. No. 54,111
Signature		
Date	11/4/04	

CERTIFICATE OF MAILING

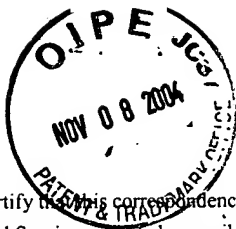
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name Karen Karlin

Signature

Date

11-4-04



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 11-4-04

TOWNSEND and TOWNSEND and CREW LLP

By: Raven Larkin

PATENT

Attorney Docket No.: 015280-393100US

Client Ref. No.: E-090-1999/0-US-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

REMALEY, Alan T. et al.

Application No.: 09/980,751

Filed: November 1, 2001

For: HOMOGENEOUS TESTS FOR
SEQUENTIALLY DETERMINING
LIPOPROTEIN FRACTIONS

Customer No.: 20350

Confirmation No. 7562

Examiner: VENCI, David J.

Technology Center/Art Unit: 1641

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office communication mailed October 6, 2004, Applicants elect Group I, claims 1-21, drawn to a method for determining the amount of cholesterol in lipoprotein fractions in a sample, and an antibody as the complex-forming agent species, and dextran sulfate as the polyanion species. Claims readable on the elected species are claims 1-6 and 8-21.

This election is made with traverse.

Basis for restriction practice is illustrated in 35 U.S.C. §121, "[i]f two or more independent and distinct inventions are claimed in one application, the Director [of the Patent and Trademark Office] may require the application to be restricted to one of the inventions." The meaning of "independent" and "distinct" is further provided by MPEP §802.01: the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed; the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part thereof, process, and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed.

The present application resides in the novel method for sequentially determining the amount cholesterol in different lipoprotein fractions of a biological sample. The subject matter of the restriction requirement, namely that of Groups I and II, are closely related as the claimed method for determining the amount of cholesterol of Group I is the basis of the utility of the claimed kit of Group II. Thus, the subjects upon which the restriction requirement is imposed are not "independent" under 35 U.S.C. §121 according to the MPEP's definition.

Nor are the subjects "distinct" under 35 U.S.C. §121 according to the MPEP's definition. Because the use of the claimed kit of Group II necessarily relies on the claimed cholesterol-measuring method of Group I, they cannot be separated from each other when the claimed kit is used to determining cholesterol levels in different lipoprotein fractions of a sample.

The claims of Group I, drawn to method for determining cholesterol levels in different lipoprotein fractions in a sample, thus provides the unifying technical feature for both Groups of claims under PCT Rule 13.1. Because of the common inventive concept and the close relation between the subject matter of Groups I and II, the examination of these two Groups together would not impose any additional, unreasonable burden on the Examiner. Accordingly, Applicants respectfully submit that the restriction requirement is improper and request that the Examiner reconsider and withdraw the requirement.

Appl. No. 09/980,751

PATENT

Resp. dated November 3, 2004

Reply to Office communication of October 6, 2004

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Chuan Gao
Reg. No. 54,111

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
CG:cg
60344804 v1